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In re the Application of:

Leigh Allen Williamson   )

Serial Number: 09/902,694   )   Group: 2157

Docket Number: AUS920010324US1   )   Examiner: Gregory G. Todd

Filed on: 07/12/2001   )

For: "Pluggable URL Providers in a   )
J2EE Server"   )

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Robert H. Frantz, Reg. No. 42,553

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APPEAL BRIEF

Real Party in Interest per 37 CFR §41.37(c)(1)(i)

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)

None.

Status of Claims per 37 CFR §41.37(c)(1)(iii)

Claims 1 - 15 are finally rejected. The rejections of Claims 1 - 15 are Appealed.

Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)

No amendments to the claims have been submitted or entered after final rejections.

Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)

This invention provides pluggable Uniform Resource Locator ("URL") protocol providers in a JAVA Version 2 Enterprise Edition ("J2EE") application server in an extensible manner, where the set of URL protocol handlers in existing application servers is relatively fixed or limited. As such, it is a server-specific invention (e.g. it has no applicability to client devices).

More specifically, independent claim 1 claims a method and independent claim 5 claims a corresponding computer-readable medium encoded with software for performing the method of:

(a)   providing one or more extension URL providers on an application server, said extension URL providers each having a specified name, description, supported protocol and stream handler class name, and classpath (pg. 15 lines 3 - 15; fig. 3 #31 - 34);

(b)   binding a reference to one or more extension URL objects into a global namespace on said application server (pg. 15, lines 19 - 20; fig. 3 #36);

(c)   registering said extension URL providers to be used by an application program in a table of parameter sets having a protocol identifier and a stream handler class identifier (pg. 16, lines 3 - 9; fig. 4 #42 - 43);

(d)   overriding said default URL stream handler to enable an extension URL stream handler (pg. 16, lines 12 - 17; fig. 4 #47 - 49); and

(e)   binding one or more extension URL objects into an application server namespace (pg. 16 lines 10 - 11; fig. 4 #44) such that said registered extension URL providers and extension URL objects are available to and for use by an application program through an application server naming service.

Independent Claim 9 claims a system for achieving the same objectives, comprising:

(a)   one or more extension URL providers on an application server, said extension URL providers each having a specified name, description, supported protocol and stream handler class name, and classpath (pg. 15 lines 3 - 15; fig. 3 #31 - 34);

(b)   a registry of said URL providers comprising a table having a parameter set for each URL provider, said parameter set comprising a protocol identifier and a stream handler class identifier (pg. 16, lines 3 - 9; fig. 4 #42 - 43);

(c)   a default URL stream handler factory overrider adapted to replace said default URL stream handler factory with a extension URL stream handler factory (pg. 16, lines 12 - 17; fig. 4 #47 - 49); and

(d)   one or more bound references for of one or more URL objects into an application server namespace (pg. 16 lines 10 - 11; fig. 4 #44) such that said registered URL providers and URL objects are available to an application program via an application server naming service.

Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)

Review by the Board of the rejections of Claims 1 - 12 under 35 U.S.C. §103(a) as being unpatentable over single reference US Patent 6,763,395 to Austin (hereinafter "Austin"), and of the rejections of Claims 13 - 15 under 35 U.S.C. §103(a) as being unpatentable over Austin in view of US Published Patent Application 2002/0104071 to Charisius (hereinafter "Charisius").

Arguments per 37 CFR §41.37(c)(1)(vii)

Rejections of Claims 1 - 12 under 35 U.S.C. §103(a) over Austin

Appellants allege that no *prima facie* case of obviousness has been properly established because the following errors in examination have occurred:

(a)   the cited reference teaches away from server-based implementations of their invention, therefore there could be no motivation to modify the reference as proposed in the rationale for the rejections;

(b)   the rationale of the rejections is improperly predicated on a motivation to "enhance" Austin's invention, which is not substantiated by the reference itself, and is contrary to the assumption that an issued patent (the Austin reference) validly discloses a best mode, in view of the fact that Austin is clearly "ordinarily skilled in the art";

(c)   the rationale for the rejections is improperly predicated on motivation to provide server-side advantages which are disclosed by Appellants, not by the cited

reference; and

(d)   the references fail to teach all of the claimed elements, steps, and limitations.

Regarding teaching away by the reference, Appellants argued that Austin teaches away from server-based implementations, which we have claimed. For example, Austin clearly states (emphasis added by Appellant):

> ... Advantageously, users may connect to a data source and view live data from the data source in a manner similar to connecting to a traditional web HTTP server and viewing a web page, **but without interacting with an HTTP server at any point**. (Austin's Abstract, emphasis added)

and, further:

> ... Advantageously, users may connect to a data source and view live data from the data source in a manner similar to connecting to a traditional web HTTP server and viewing a web page, **but without interacting with an HTTP server at any point.** ... (Col. 2 lines 63 - 67, emphasis added)

and:

> In step 308, the data viewer component 204 connects to the data source identified by the URL and retrieves data from the data source. As illustrated in FIG. 4, the viewer component 204 may connect to a data source 212 via a network 208 such as a LAN, WAN, the Internet, etc. The viewer component 204 may also connect to a data source 212 which is included in the same computer system that is running the user agent or is attached to the computer system via a mechanism other than a network, e.g. an attached instrument or device as described with reference to FIG. 2. In the preferred embodiment, the data viewer may connect or couple to the data source **without connecting to a web server and without utilizing any web server protocols**. (Col. 9 line 58 - col. 10 line 3, emphasis added)

additionally:

> Austin's Claim 12 (emphasis added):
> The method of claim 1, wherein said connecting to the measurement device specified by the URL **does not include connecting to a web server.**

and, still further:

> Austin's Claim 64 (emphasis added):
> The method of claim 58, wherein the data viewer connects to the data source specified by the URL **without connecting to a web server**.

and, even additionally:

> Austin's Claim 65 (emphasis added):
> The method of claim 58, wherein the data viewer connects to the data source specified by the URL **without utilizing standard web server protocols**.

Applicant submits that Austin was communicating an undesirability of connecting to a server and using server protocols by so many explicit statements against such methods. Such desirability must be found in the cited art, not in the applicant's disclosure, per MPEP § 2143.01.

In the rationale for the final rejections, Examiner did not respond to this argument, other than to remind the Appellant that Austin "teaches at least the user agent *communicating* with an HTTP server" (emphasis added by applicant). This does not relieve the Examiner of the burden of substantiating where in Austin the suggestion of *modifying* as proposed, not just *communicating with* a web server, and where in Austin the enabling disclosure of *how* to make such a modification is found.

Examiner's argument also does not address or otherwise counter Appellent's interpretation of the cited passages which seem to teach away from such a modification. It is improper to maintain an obviousness rejection in the clear contravention of the teachings of the cited reference. Would it have been obvious to one ordinarily skilled in the art to read Austin's

disclosure setting forth a client-side implementation, and strongly denouncing server-side implementation, to sally forth to create a server-side implementation anyway, despite the negative comments of Austin? Appellants believe that it would not have been obvious to do so. MPEP 2143.01 and the case law cited therein support this position.

Regarding Applicant's argument that Austin himself is "one ordinarily skilled in the art" and that if it had been obvious to "enhance" Austin's client-side system by implementing our claimed functions on a server instead, Austin would have disclosed this enhanced embodiment, Examiner has dismissed this argument as being "improper and illogical". With due respect, the argument is fully logical, and proceeds as such:

(A)   The *Examiner* (not the Appellants) has cited the motivation to modify Austin as proposed in the final rejections would have been to "**enhance** Austin's system to have the server-side ... handle processing .. thus allowing fewer systems to need to be up to date and be updated, ..." (Pg. 3 line21 - pg. 4 line 2 of the Office Action dated 4/20/2005, emphasis added by Appellant). Please note that most of the text of this reasoning describing the advantages of such a server-side implementation are not found or cited from Austin as discussed in the foregoing paragraphs of this Appeal Brief.

(B)   As this motivation to 'enhance' Austin's disclosed client-side embodiment would necessarily and logically provide a 'better' mode of Austin's invention (e.g. the definition of 'enhance' is to improve), then one must consider the background of Austin as an inventor, to determine if he is one of ordinary skill in the art, because if he was, then this undisclosed better embodiment would not be an obvious embodiment due to the presumption of validity of an issued patent (Austin's patent in this case) which inherently presumes that the requirement to disclose a best mode has been met.

(C)   Upon research into Austin's background, Appellant's argued that Austin was likely "one of ordinary skill in the art", as the USPTO database indicates eleven

patents have issued naming Mr. Paul F. Austin as an inventor (6,763,395: 6,751,653; 6,643,691; 6,542,166; 6,526,566; 6,515,682; 6,370,569; 6,256,625; 5,974,257; 5,870,088; 5,504,917). Appellant contends that because the earliest of these patents issued in 1996, and the latest of them issued in 2004, there is evidence that Mr. Austin has 7 or more years of experience in the relevant arts, and thus is one of ordinary skill in the art.

(D)   Therefore, because:

       (1)   Mr. Austin was one ordinarily skilled in the art; AND

       (2)   the cited Austin patent is presumed valid; AND

       (3)   valid patents must include a best mode; THEREFORE

       (4)   the proposed "enhanced" or better mode of modifying Austin to implement server-side functionality which is not disclosed cannot be an obvious modification, else it would have been disclosed by Mr. Austin as an ordinarily skilled person in the art, recognizing an obviously better mode of his invention, and complying with the requirements of disclosing his best mode.

As such, examiner's argument, which relies upon "enhancement" for motivation to modify Austin, is not substantiated by the facts of the case.

Regarding Appellant's argument in the last reply to the Examiner that the rejections are improperly predicated on motivation to provide server-side advantages which are disclosed by Appellants, not by the cited reference, the Examiner has again failed to provide any counter to this argument. Thus, Appellants maintain this argument on Appeal. Advantages of the Appellant's invention, discussed in the foregoing paragraphs, which relate to server-side implementation cannot be properly used to provide motivation for combination of the cited art, unless the cited art itself recognizes the same advantages.

Rejections of Claims 13 - 15 under 35 U.S.C. §103(a) over Austin in view of Charisius

In the rationale for the finale rejections of Claims 13 - 15, the examiner reasoned that as Austin failed to teach or suggest our invention as implemented on a J2EE server, US Patent Application 2002/0104071 to Charisius provides such teaching, and it would have been obvious to modify Austin to employ the J2EE server teachings of Charisius.

Charisius is directed towards software development tools, and provides no teaching regarding pluggable URL providers as we have claimed. Thus, the rationale for the rejections of Claims 13 - 15 depend on the teachings of Austin to meet the claim limitations of the independent claims from which Claims 13 - 15 depend.

For the reasons stated in the foregoing paragraphs, Austin fails to teach all of the claimed steps, elements, and limitations, and thus Austin in view of Charisius fails to teach the same claimed steps, elements and limitations.

Summary of Arguments

For the foregoing reasons, it is submitted that the rejections of Claims 1 - 15 were erroneous because:

(a)   the Austin reference teaches away from server-based implementations of their invention, therefore there could be no motivation to modify the reference as proposed in the rationale for the rejections;

(b)   the rationale for the rejections is improperly predicated on motivation to provide server-side advantages which are disclosed by Appellants, not by the cited references;

(c)   the rationale of the rejections is improperly predicated on a motivation to "enhance" Austin's invention, which is not substantiated by the reference itself, and is contrary to the assumption that an issued patent (the Austin reference) validly discloses a best mode, in view of the fact that Austin is clearly "ordinarily skilled in the art"; and

(d)   the references fail to teach all of the claimed elements, steps, and limitations.

Reversal of all rejections is respectfully requested.

Respectfully,

/ Robert Frantz /

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Claims Appendix
per 37 CFR §41.37(c)(1)(viii)

Clean Form of Amended Claims

Claim 1 (original):

A method of providing an extension to a default set of resource functions in an enterprise application server, said application server having a default Universal Resource Locator (URL) stream handler factory class, said method comprising the steps of:

providing one or more extension URL providers on an application server, said extension URL providers each having a specified name, description, supported protocol and stream handler class name, and classpath;

binding a reference to one or more extension URL objects into a global namespace on said application server;

registering said extension URL providers to be used by an application program in a table of parameter sets having a protocol identifier and a stream handler class identifier;

overriding said default URL stream handler to enable an extension URL stream handler; and

binding one or more extension URL objects into an application server namespace such that said registered extension URL providers and extension URL objects are available to and for use by an application program through an application server naming service.

Claim 2 (original):

The method as set forth in Claim 1 further comprising the steps of:

executing a computer instruction by an application program to lookup a resource object by a resource name via an application server naming service; and

retrieving a bound and registered extension URL object according to said resource name.

Claim 3 (previously presented):

>   The method as set forth in Claim 1 wherein said step of providing one or more extension URL providers includes specifying a classpath as a location of a jar file.

Claim 4 (original):

>   The method as set forth in Claim 1 wherein said step of overriding said default URL stream handler is performed by executing a Java function to set the application server's URL Stream Handler Factory to said extension URL stream handler.

Claim 5 (original):

>   A computer readable medium encoded with software for providing an extension to a default set of resource functions in an enterprise application server, said application server having a default Universal Resource Locator (URL) stream handler factory class, said software when executed by an application server to perform the following steps:

>   provide one or more extension URL providers on an application server, said extension URL providers each having a specified name, description, supported protocol and stream handler class name, and classpath;

>   bind a reference to one or more extension URL objects into a global namespace on said application server;

>   register said extension URL providers to be used by an application program in a table of parameter sets having a protocol identifier and a stream handler class identifier;

>   override said default URL stream handler to enable an extension URL stream handler; and

>   bind one or more extension URL objects into an application server namespace such that said registered extension URL providers and extension URL objects are available to and for use by an application program through an application server naming service.

Claim 6 (original):

The computer-readable medium as set forth in Claim 5 further comprising software for

performing the steps of:

executing a computer instruction by an application program to lookup a resource

object by a resource name via an application server naming service; and

retrieving a bound and registered extension URL object according to said

resource name.

Claim 7 (previously presented):

The computer-readable medium as set forth in Claim 5 wherein said software for

providing one or more extension URL providers includes software for specifying a

classpath as a location of a jar file.

Claim 8 (original):

The computer-readable medium as set forth in Claim 5 wherein said software for

overriding said default URL stream handler is comprises software for executing a Java

function to set the application server's URL Stream Handler Factory to said extension

URL stream handler.

Claim 9 (original):

An extensible Universal Resource Locator (URL) resource system for an enterprise application server, said enterprise application server having a default set of resource functions in an enterprise application server and a default Universal Resource Locator (URL) stream handler factory class, said extensible URL resource system comprising:

one or more extension URL providers on an application server, said extension URL providers each having a specified name, description, supported protocol and stream handler class name, and classpath;

a registry of said URL providers comprising a table having a parameter set for each URL provider, said parameter set comprising a protocol identifier and a stream handler class identifier;

a default URL stream handler factory overrider adapted to replace said default URL stream handler factory with a extension URL stream handler factory; and

one or more bound references for of one or more URL objects into an application server namespace such that said registered URL providers and URL objects are available to an application program via an application server naming service.

Claim 10 (original):

The extensible Universal Resource Locator (URL) resource system as set forth in Claim 9 further comprising:

a lookup facility for looking up a resource object by a resource name for use by an application program; and

a URL object retriever adapted to retrieve a bound and registered URL object according to said looked-up resource name.

Claim 11 (previously presented):

 The extensible Universal Resource Locator (URL) resource system as set forth in Claim 9 wherein said extension URL providers include a classpath specifying a location of a jar file.

Claim 12 (original):

 The extensible Universal Resource Locator (URL) resource system as set forth in Claim 9 wherein said default URL stream handler overrider comprises a Java function to set the application server's URL Stream Handler Factory to said extension URL stream handler.

Claim 13 (previously presented):

 The method as set forth in Claim 1 wherein:

  said one or more extension URL providers on an application server comprise a provider compatible with or compliant with Java 2 Enterprise Edition (J2EE) specifications;

  said step of binding a reference to one or more extension URL objects into a global namespace on said application server comprises binding into a J2EE global namespace;

  said step of registering said extension URL providers comprises registering with a J2EE application server;

  said step of overriding said default URL stream handler to enable an extension URL stream handler comprises overriding a J2EE URL stream handler; and

  said step of binding one or more extension URL objects into an application server namespace comprises binding into a J2EE application server namespace such that said registered extension URL providers and extension URL objects are available to and for use by a J2EE application program through an application server naming service.

Claim 14 (previously presented):

The computer-readable medium as set forth in Claim 5 wherein:

said one or more extension URL providers on an application server comprise a provider compatible with or compliant with Java 2 Enterprise Edition (J2EE) specifications;

said software for binding a reference to one or more extension URL objects into a global namespace on said application server comprises software for binding into a J2EE global namespace;

said software for registering said extension URL providers comprises software for registering with a J2EE application server;

said software for overriding said default URL stream handler to enable an extension URL stream handler comprises software for overriding a J2EE URL stream handler; and

said software for binding one or more extension URL objects into an application server namespace comprises software for binding into a J2EE application server namespace such that said registered extension URL providers and extension URL objects are available to and for use by a J2EE application program through an application server naming service.

Claim 15 (previously presented):

    The system as set forth Claim 9 wherein:

        said one or more extension URL providers on an application server comprise Java Version 2 Enterprise Edition (J2EE) compliant or compatible URL providers;

        said registry of said URL providers comprises a J2EE registry;

        said default URL stream handler factory overrider is adapted to replace a default J2EE URL stream handler factory with a extension URL stream handler factory; and

        said one or more bound references for of one or more URL objects into an application server namespace comprise J2EE namespace bindings such that said registered URL providers and URL objects are available to a J2EE application program via an application server naming service.

Evidence Appendix
per 37 CFR §41.37(c)(1)(ix)

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

Related Proceedings Appendix

per 37 CFR §41.37(c)(1)(x)

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).